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09/500,439	02/09/2000	Joann Ruvolo	AM9-99-0133	2623

26381 7590 02/03/2004

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ALEXANDRIA, VA 22314

EXAMINER
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GART, MATTHEW S

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 02/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/500,439

Applicant(s)

RUVOLO ET AL.

Examiner

Matthew s Gart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Upon consideration of the issues raised in the "Order Returning to Examiner" mailed November 10, 2003, PROSECUTION IS HEREBY REOPENED.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

The prosecution has been reopened in order to correct a typographical error on Page 5 of Paper No. 10. Such error precipitated confusion regarding the Examiner's grounds for rejection of claims 5-8, 18-20 and 29-32.

A corrected Office Action on the merits follows. Additionally, the Examiner has responded to arguments advanced in the Appeal Brief filed May 6, 2003 beginning on Page 10.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-4, 9-17, 21-28, and 33-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Xcontact in view of Official Notice.**

Referring to claims 1, 14, and 26. Xcontact discloses a computer-based method, system, and article of manufacture equivalent to a computer-based method, system, and article of manufacture of dynamically presenting potential contacts to a user comprising the following:

- Retaining user preferences in computer storage (at least page 4, *sort functions*);
- Retaining a list of possible contacts (at least page 4, *contact list*);
- A contact list stored in computer storage, said contact list comprising at least identifying information and available images of said contacts (at least page 4, *browser sample*);
- A list comprising at least identifying information of said contacts (at least page 4, *browser sample*);
- Automatically searching said list of possible contacts to select a potential contact based on said user preferences (at least page 4, *powerful search functions*);
- Retaining potential contacts selected during said search (at least page 4, *last search is saved*);

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- Displaying to the user an available image or other identifying information of a potential contact (at least page 4, *browser sample*).
- A manual request unit (at least page 4, *powerful search functions*);
- A time-based request unit providing an invocation for time-based automatic searching (at least page 3, *alarms*); and
- A request processor, said processor detecting an invocation output from said manual request unit or said time-based request unit and initiating said search module to select one or more possible contacts, and wherein said selected candidates are stored in computer storage and processed to display, by said display module, said selected contact image or information to the user (at least page 4, *last search is saved, so the Contact List window will be displayed automatically...*).

Xcontact does not expressly disclose automatically searching a list of possible contacts. Examiner takes Official Notice that it was known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of searching a list for possible contacts based upon the information from a user gives you just what you would expect from the manual step as shown in Xcontact. In other words there is no enhancement found in the claimed step. The claimed searching step only provides automating the manual activity. The end result is the same as compared to the manual method. It would have been obvious to a person

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of ordinary skill in the art at the time of the invention to automate searching a list for possible contacts because this would allow a fast indexed and global search.

Referring to claims 2 and 15. Xcontact further discloses user preferences wherein said user preferences comprise either preferences input by the user (at least page 4, *browser sample*) or pre-selected default preferences (at least page 4, *sort functions*).

Referring to claims 3, 9, 16, 21, 27, and 33. Xcontact in view of Official Notice discloses a computer-based method, system, and article of manufacture according to claims 1, 14, and 26 as indicated supra. Xcontact further discloses user preferences wherein said user preferences comprise any of:

- Professional or personal contact (at least page 4, *browser sample*),
- Automatic preference on initiating the searching step (at least page 3, *alarms* and page 4, *sort functions*).

Xcontact does not expressly disclose a computer-based method, system, and article of manufacturer wherein said search step is repeated until a maximum number of candidates for selection has been achieved. Examiner takes official notice that a search step that is repeated until a maximum number of search results are achieved was art recognized at the time of the invention. It would have been obvious for a maximum number of search results to be achieved during a search step in order to provide the user with an efficient and accurate searching means. Accordingly, it would have been obvious to one of ordinary skill in the art to modify the system of Xcontact to

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include a search step that is repeated until a maximum number of search results are achieved.

Referring to claims 4, 17, and 28. Xcontact further discloses a list of contacts comprising any of: Name, organization, work address, home address, telephone numbers, pager numbers, cellular numbers, e-mail address, personal or professional identifiers, special dates, and contact dates (at least page 4, *browser sample*).

Referring to claims 10, 22, and 34. Xcontact further discloses a computer-based method and system wherein displaying step further comprises insertion of said available image or identifying information into a GUI (at least page 4, *browser sample*).

Referring to claims 11, 23, and 35. Xcontact further discloses a computer-based method and system wherein a GUI comprises an electronic organizer (at least page 2, *browser sample*).

Referring to claims 12-13, 24-25, and 36-37. Xcontact further discloses a method and system wherein said method and system may be implemented locally or remotely on one or more computer based systems, across networks, LANs, WANs, cellular, Internet, Web-based networks or existing communication mediums (at least page 3, *compatible with your WEB Browser and E-mailer*).

**Claims 5, 7-8, 19-20, 29, and 31-32 are rejected under 35 U.S.C. 103(a) as being anticipated by Xcontact in view of Official Notice, in further view of Kennedy et al. U.S. Patent No. 5,831,611.**

Referring to claim 5. Xcontact in view of Official Notice discloses a computer-based method according to claim 1 as indicated supra. Xcontact in view of Official

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Notice does not expressly disclose a searching step wherein said searching step is initiated automatically by a time-based reference in the user preferences. Kennedy et al. discloses a searching step wherein said searching step is initiated automatically by a time-based reference in the user preferences (at least column 2, lines 46-58 and claims 12-13). Although this form is not found in Xcontact, it would have been obvious to provide the method of Xcontact to include the limitations as taught by Kennedy in order for an individual to establish, develop, and maintain relationships with customers and vendors. Moreover, to have modified the method of Xcontact to have included the search step components would have been obvious to the skilled artisan because the inclusions of such components would have been an obvious matter of design choice in light of the method already disclosed by Xcontact. Such modifications would not have otherwise affected the method of Xcontact and would merely represent one of numerous steps that the skilled artisan would have found obvious because the successful performance of a business relies upon establishing and then adhering to a set of contact communication protocols (at least column 1, lines 15-27) as disclosed by Kennedy et al. Additionally applicant has not persuasively demonstrated the criticality of providing this step versus the step disclosed by Xcontact.

Referring to claims 6, 18, and 30. Xcontact in view of Official Notice discloses a computer-based method and a computer media product according to claims 3, 14, and 29 as indicated supra. Xcontact does not expressly disclose a computer-based method and a computer media product wherein a time-based reference comprises any of: frequency of contact, time between contacts or calendar-based contact. Kennedy et al.



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discloses a computer-based method wherein a time-based reference comprises any of: frequency of contact, time between contacts or calendar-based contact (at least column 2, lines 13-58). Although this form is not found in Xcontact, it would have been obvious to provide the method of Xcontact to include the limitations as taught by Kennedy in order for an individual to establish, develop, and maintain relationships with customers and vendors. Moreover, to have modified the method of Xcontact to have included the time-based reference components would have been obvious to the skilled artisan because the inclusions of such components would have been an obvious matter of design choice in light of the method already disclosed by Xcontact. Such modifications would not have otherwise affected the method of Xcontact and would merely represent one of numerous steps that the skilled artisan would have found obvious because the successful performance of a business relies upon establishing and then adhering to a set of contact communication protocols (at least column 1, lines 15-27) as disclosed by Kennedy et al. Additionally applicant has not persuasively demonstrated the criticality of providing this step versus the step disclosed by Xcontact.

Referring to claims 7, 19, and 29. Xcontact in view of Official Notice discloses a computer-based system and an article of manufacture for dynamically selecting possible contacts according to claims 5, 16, and 26 as indicated supra. Xcontact in view of Official Notice does not expressly disclose a search module comprising, comparing applicable time-based references stored in said user preferences with said timer module, and upon a positive comparison, initiating said search. Kennedy et al. discloses a search module comprising, comparing applicable time-based references

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stored in said user preferences with said timer module, and upon a positive comparison, initiating said search (at least column 1, lines 38-59). Although this form is not found in Xcontact, it would have been obvious to provide the method of Xcontact to include the limitations as taught by Kennedy in order for an individual to establish, develop, and maintain relationships with customers and vendors. Moreover, to have modified the method of Xcontact to have included the time-based reference components would have been obvious to the skilled artisan because the inclusions of such components would have been an obvious matter of design choice in light of the method already disclosed by Xcontact. Such modifications would not have otherwise affected the method of Xcontact and would merely represent one of numerous steps that the skilled artisan would have found obvious because the successful performance of a business relies upon establishing and then adhering to a set of contact communication protocols (at least column 1, lines 15-27) as disclosed by Kennedy et al. Additionally applicant has not persuasively demonstrated the criticality of providing this step versus the step disclosed by Xcontact.

Referring to claims 8, 20, and 32. Xcontact in view of Official Notice discloses a computer-based method and a computer-based system according to claims 1, 14, and 26 as indicated supra. Xcontact in view of Official Notice does not expressly disclose a computer-based system and a computer-based method wherein selection of a potential contact in said search step is either random or based on a select algorithm. Kennedy et al. discloses a computer-based system and a computer-based method wherein selection of a potential contact in said search step is either random or based on

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a select algorithm (at least column 1, line 15 to column 2, line 10). Although this form is not found in Xcontact, it would have been obvious to provide the method of Xcontact to include the limitations as taught by Kennedy in order for an individual to establish, develop, and maintain relationships with customers and vendors. Moreover, to have modified the method of Xcontact to have included the search step components would have been obvious to the skilled artisan because the inclusions of such components would have been an obvious matter of design choice in light of the method already disclosed by Xcontact. Such modifications would not have otherwise affected the method of Xcontact and would merely represent one of numerous steps that the skilled artisan would have found obvious because the successful performance of a business relies upon establishing and then adhering to a set of contact communication protocols (at least column 1, lines 15-27) as disclosed by Kennedy et al. Additionally applicant has not persuasively demonstrated the criticality of providing this step versus the step disclosed by Xcontact.

Referring to claim 31. Xcontact in view of Official Notice discloses an article of manufacture comprising a computer media product implementing a process for selecting and presenting to a user possible candidates for contact according to claim 31 as indicated supra. Xcontact in view of Official Notice does not expressly disclose a search comprising, comparing applicable time-based references stored in said user preferences with a timer function, and upon a positive comparison, initiating said search. Kennedy et al. discloses a search comprising, comparing applicable time-based references stored in said user preferences with a timer function, and upon a

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positive comparison, initiating said search (at least column 1, lines 38-59). Although this form is not found in Xcontact, it would have been obvious to provide the method of Xcontact to include the limitations as taught by Kennedy in order for an individual to establish, develop, and maintain relationships with customers and vendors. Moreover, to have modified the method of Xcontact to have included the search step components would have been obvious to the skilled artisan because the inclusions of such components would have been an obvious matter of design choice in light of the method already disclosed by Xcontact. Such modifications would not have otherwise affected the method of Xcontact and would merely represent one of numerous steps that the skilled artisan would have found obvious because the successful performance of a business relies upon establishing and then adhering to a set of contact communication protocols (at least column 1, lines 15-27) as disclosed by Kennedy et al. Additionally applicant has not persuasively demonstrated the criticality of providing this step versus the step disclosed by Xcontact.

### ***Response to Argument***

#### ***Referring to Independent Claims 1 and 26***

The Appellant argues at page 11 of the Brief, that "Xcontact does not, either explicitly or implicitly, teach or suggest a system or method for using the contact information stored within to intelligently and automatically remind the user to keep in communication with specific contacts over time, based on pre-stored preferences."

The Examiner notes that Xcontact teaches a system and method, which can save "any information about your contacts." Xcontact can then provide a fast indexed

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and global search of those contacts. Xcontact can further provide the user with alarms that can remind the user of particular important events. Xcontact further provides a Sort function, whereby a user can search by various user specified data, this user specified data is based on a user's preference. The user chooses which data to sort and search, and then a sort or search function is performed.

The Appellant argues that Xcontact does not "...intelligently and automatically remind the user to keep in communication with specific contacts over time."

The Examiner notes, all of the independent claims (1, 14 and 26) of the instant invention refer to automatically searching possible contacts. The independent claims do not reference automatically reminding a user. Automatically searching refers to the automatic data mining of a data storage device, and not necessarily automatically presenting a result that acts to remind the user of a specific event. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Appellant argues that the "...sort function as used in Xcontact does not refer to preferences, but instead refers to various fields, such as First Name, Name, or Company. By contrast, the term 'Preference', as used in applicants' specification and claims define: the type of contact, the time-based frequency of contact in an automatic invocation, the type of selection algorithm, etc."

The Examiner notes, that neither independent claim 1 nor claim 26 defines "Preferences" as a type of contact, as time-based or as algorithm based. Although the

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claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Appellant argues that Xcontact does not disclose a “time-based request unit providing an invocation for time-based automatic searching.”

The Examiner notes that the feature upon which applicant relies are not commensurate with the scope of independent claim(s) 1 and 26. These claims were given the broadest reasonable interpretation in an effort to reduce the possibility that these claims; once issued, will be interpreted more broadly than is justified. See *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969).

#### ***Referring to Independent Claim 14***

The Appellant argues that Xcontact does not disclose a “time-based request unit providing an invocation for time-based automatic searching.”

The Examiner notes, Xcontact does disclose the use of Alarms to remind a user of a particular important event. An alarm by definition is a time-based reminder and is used to automatically initiate an event. Furthermore as applied in subsequent dependent claims, Kennedy discloses a method wherein a scheduled event includes the step of prompting a user for intervention (Kennedy: claim 13). Kennedy further teaches an appointment calendar and the scheduling of future appointments and automatic follow-up reminders (Kennedy: column 1, lines 49-59).

***Referring to Subsequent Dependent Claims***

The Appellant argues that the "... sort function as used in Xcontact does not refer to preferences, but instead refers to various fields, such as First Name, Name, or Company. By contrast, the term 'Preference', as used in applicants' specification and claims define: the type of contact, the time-based frequency of contact in an automatic invocation, the type of selection algorithm, etc."

The Examiner notes, this limitation is addressed in the rejection of subsequent dependent claims (i.e. claims 5-8, 18-20 and 29-32) whereby Xcontact in view of Kennedy and Official Notice obviates those particular claims. Kennedy provides a communication management system, which automatically applies a communication protocol to a set of database entries representing a wide and diverse variety of business contacts in order to generate and execute a set of scheduled events (Kennedy: column 2, lines 17-21). Kennedy further teaches a system that provides programming tools which enable businesses to quickly and easily develop contact communication protocols which are then applied generally to a database of business contacts (Kennedy: column 1, line 60 to column 2, line 9).

***Conclusion***

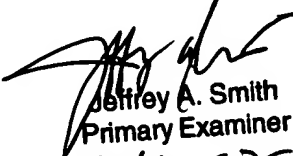
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew s Gart whose telephone number is 703-305-5355. The examiner can normally be reached on 8:30AM to 5:00PM m-f.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MSG  
January 23, 2004

  
Jeffrey A. Smith  
Primary Examiner  
Acting SPE  
AU 3625